

### **REMARKS/ARGUMENTS**

Claims 1 - 38 remain pending in the application. Claims 1 – 38 stand rejected. No new matter has been introduced into the application. As explained in more detail below, the Applicants submit that all claims are now in condition for allowance and respectfully request such action.

#### **Rejection under 35 USC §103 – Meadows in view of Sarwal**

Claims 1 – 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,381,496 (“Meadows”) in view of U.S. Patent No. 6,662,052 (“Sarwal”). The Applicants traverse the rejection in view of the following Remarks.

Meadows relates to an implantable stimulating device having the ability to perform context switching. Meadows defines context switching as “changing one set of operational parameters to another.” (Col. 3, ll. 6-10). Indeed, Meadows teaches a programmable implantable device where the patient may “advantageously swap the current set of operational parameters with another set of operational parameters.” (Col. 3, ll. 11-15).

Sarwal relates to a wireless “external stimulator with predetermined (pre-packaged) stimulation program...[where a] physician situated remotely is also able to activate predetermined programs, as well as interrogate the external stimulation devices.” (Col. 1, ll. 21-33).

The Office Action states that it would have been obvious to use the bi-directional communication taught by Sarwal with the device of Meadows “to test various parameters before final programming of the internal stimulator”. The Applicants traverse this rejection on the following grounds. First, no reference by itself or in combination with any other reference

discloses the limitations set forth in the pending claims. Second, the Office Action fails to make a *prima facie* showing of a suggestion to make the combination relied upon in rejecting the claims.

**A. The references fail to disclose each of the limitations of the pending claims**

The cited references fail to disclose, teach, or suggest a bi-directional communications link that, among other things, “enable[s] the external neural stimulator to provide final therapy parameter settings to the programmer,” whereby the programmer may then program an implantable neural stimulator using final therapy parameters,” as recited for example in claim 1. This allows the programmer to obtain the appropriate therapy parameters directly from the external neural stimulator and avoiding the need for manual programming. As a result, the present invention provides a programmer that may be used in both screening and treating stages.

Indeed, Meadows discloses a programmer for swapping the “current set of operational parameters with another set of operational parameters.” (Col. 3, ll. 11-15). Similarly, Sarwal relates to a wireless “external stimulator with predetermined (pre-packaged) stimulation programs.” (Col. 1, ll. 21-23). Neither of these references discloses, teaches, or suggests the use of a single programming device for use in both the screening and treating stages, much less even the possibility of allowing an external neural stimulator to provide final therapy parameter settings to the programmer. Because the references do not teach a programmer configured for use during the screening and treating phase by different classifications of users, they cannot render the present invention obvious.

**B. There is no teaching, suggestion or disclosure to combine or modify the cited reference to achieve the claimed invention**

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The Office Action states that it would have been obvious to use the bi-directional communication taught by Sarwal with the device of Meadows "to test various parameters before final programming of the internal stimulator". The Office Action, however, fails to state a basis for combining the teachings of Meadows with Sarwal, and furthermore fails to recognize that the combination of the references would not achieve the present invention. Even when combining the device of Meadows with the bi-directional communication disclosed in Sarwal, there is no suggestion of a bi-directional communications link that, among other things, enables an external stimulator to provide final therapy parameter settings to a programmer, whereby the programmer may then program an implantable neural stimulator.

It is, therefore, respectfully submitted that the cited references do not individually or collectively disclose or suggest the invention as presently claimed. The applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

**CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,

Dated: January 20, 2005



---

Binal J. Patel  
Reg. No. 42,065

BANNER & WITCOFF, LTD.  
10 South Wacker Drive  
Suite 3000  
Chicago, Illinois 60606  
Tel: (312) 463-5000  
Fax: (312) 463-5001